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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/132,746	08/12/1998	HAJIME YAMAMOTO	35.C12902	9960

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EXAMINER

GUARRIELLO, JOHN J

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/132746

Applicant(s)

Yamamoto et al.

Examiner

John Guarriello

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2/24/2003, 3/14/2003
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-6, 11-25, 30-39, 42, 47-62, 65, 68-76, 79-95 is/are pending in the application.
Of the above claim(s) 1-6, 11-17, 31-39, 54-62, 79, 82, 83, 87, 90-92 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 18-25, 30, 42, 47-53, 65, 68-76, 80, 81, 84-86, 88, 89, 93-95 is/are rejected.
- ☒ Claim(s) 18, 42, 65 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

15. The Examiner acknowledges papers # 25-27, the extension of time, the reconsideration of 2/24/2003; and the letter with the substitute specification have been entered of 3/14/2003.

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restriction

17. The restriction is made final as noted in paper # 17 of 6/6/2001. Upon the submission of new claims 87-95, non-elected claims are 87, 90-92. New claims 88, 89, 93-95 are directed to the elected invention, Group II, fibrous material. Non-elected claims 1-6, 11-17, 31-39, 54-62, 79, 82, 83 are also withdrawn as noted by the election.

Specification

18. With the submission of the substitute specification the trademark issue is resolved.

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Claim Objections

19. Claims 18, 42, and 65 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous article claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form which is to the elected invention a fibrous material, Group II, or rewrite the claim(s) in independent form. Applicant's arguments have been considered but the arguments are predicated upon the petition which is not present in the application, thus the arguments are not persuasive.

Claim Rejections - 35 USC § 102

20. Claims 18-21, 30, 42, 65, 71, 72, 76, 88, 89 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 771 662.

EP'662 describes an ink absorbing body which stores ink, (see abstract). EP'662 describes the surface of the ink absorbing body is treated with a surfactant,(page 8, lines 2-51), in the range of 0.002 to 0.2 wt.% relative to the weight of the ink, or in a range of 0.01 to 0.5 wt.% relative to the weight

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of the fiber, (see abstract; page 7, lines 10-53). EP'662 describes a polypropylene ink tank container, (page 10, lines 10-15). EP'662 describes the essential limitations of the claimed invention. Claims lack novelty.

Applicant's further arguments and attachment regarding glycol treatment have been reconsidered but they are not deemed to be persuasive because '662, Yamamoto, describes the use of polyethylene glycol treatment, see page 8, lines 4-7, in particular polyethylene glycol aliphatic carboxylic acid ester (page 8, line 4). Yamamoto also teaches that polyether type surfactant (page 8, line 48) can be used, which inherently encompasses the instantly claimed ethylene oxide adduct of a glycol. Further, Yamamoto expressly teaches that nonionic surfactant containing polyoxyethylene alkyl ether as a primary component (60-80%) within a range of 0 to 2% in fiber weight ratio (page 8, lines 36-37). Thus, clearly both "polyethylene glycol" type and "polyhydric alcohol" type non-ionic surfactant can be used contrary to applicants

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arguments. It is the Examiner's position that the rejection is maintained for the reasons given heretofore, claims lack novelty

Claim Rejections - 35 USC § 103

21. Claims 18-25, 30, 42, 47-53, 65, 68-76, 80, 81, 84-86, 88, 89, 93-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ujita et al. 5,784,088 in view of Koitabashi et al. 5,509,140.

Rejection is maintained substantially as in paper # 13 of 9/11/200 and paper # 17 of 6/6/2001, and in paper # 24 of 10/17/2002. Applicant's arguments regarding Ujita with a treatment for hydrophilic properties of the fibrous materials (like spun yarn) have been considered but the problem of ink flow, (column 3, lines 36-38) are described. Applicant's arguments regarding Koitabashi with the surfactant have been considered but Koitabashi describes anionic surfactants (column 38, lines 49-66; column 39, lines 1-5) as well as nonionic surfactants, (column 3, lines 41-66). Koitabashi describes acetylene glycol-ethylene oxide adducts and how it affects image quality and penetration of the ink. The claimed invention would still be obvious to one of ordinary

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skill without evidence of aspects of criticality of the amounts of the components required for the claimed invention.

Applicant's arguments regarding the glycol were responded to in the action of paper # 13 of 9/11/2000, paragraph # 22, page 6. Further, applicant's arguments regarding glycol treatment were responded to in paragraph # 20 of this action regarding the attachment submitted 2/24/2003.

22. Claims 22-25, 47-53, 68-70, 73-75, 84-86, 93-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 771 662 in view of Koitabashi et al. 5,509,140.

EP'662 as above in paragraph # 20. EP'662 differs from the claimed invention because the treating agent glycol is different.

Koitabashi as in paper # 13 of 9/11/2000, paragraph 22, page 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the ethylene oxide adduct of acetylene glycol of Koitabashi for the glycol surfactant of EP'662 motivated with the

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expectation that this would be an improvement in the ink transfer properties of the ink absorbing member of EP'662.

Applicant's arguments regarding the glycol have been considered, but they are not deemed to be persuasive because these were answered in paper # 13 of 9/11/2000, paragraph 22, page 6, and further reconsidered in paragraph # 20 of this action and further amplified to reflect applicant's present response of 2/24/2003.

Double Patenting

23. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

24. Claims 18-25, 30, 42, 47-53, 65, 68-76, 80, 81, 84-86, 88, 89, 93-95 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,234,618 in view of EP 771 662. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the hydrophobicity of the fibers of '618 with the surfactant of EP'662 as described motivated with the expectation that treatment of the fibers by surfactants corresponding to EP 771 662, page 8, lines 3-50, for hydrophobic properties is routine in the art and the optimization of the appropriate amounts of the surfactants and types of surfactants (non-ionic, ionic, cationic, or anionic) to accomplish this treatment of the fibers for

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hydrophobicity are routine to the person of ordinary skill in the fiber treatment art, see *In re Aller*, 105 USPQ 233.

Regarding applicant's present response of 7/30/2002, EP'662 does describe a glycol treatment, page 8, lines 4-7. Further, see paragraph #20 of this action.

Regarding applicant's request for an interview, if upon the detailed analysis of this action in response to applicant, an interview is still required, applicant is requested to telephone the Examiner for options of times and dates.

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is (703) 308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


John J. Guarriello:gj

Patent Examiner

May 30, 2003


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700